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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,000	04/26/2001	Frank Charles Pagano	Rev 98-25	7885
26807	7590	12/23/2005	EXAMINER	
JULIE BLACKBURN REVLON CONSUMER PRODUCTS CORPORATION 237 PARK AVENUE NEW YORK, NY 10017			GOLLAMUDI, SHARMILA S	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/843,000	Applicant(s) PAGANO ET AL.	
	Examiner Sharmila S. Gollamudi	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of Amendments and Remarks filed 10/12/05 is acknowledged. Claims **61-88** are pending in this application. Claims 1-60 stand cancelled.

Specification

The objection for introducing new matter into the disclosure under 35 U.S.C. 132(a) since withdrawn in view of the amendment of 10/12/05.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 61-66 and 87 are rejected under 35 U.S.C. 102(b) as being anticipated by Strella et al (3,928,656).

Strella discloses a method of developing electrostatic latent images with pressure sensitive toner. The toner comprises 19 parts of an ionic polymer (15.8%), 100 parts of tetrahydrofuran (ether solvent-83.3%), and 1 part Mogul black (pigment- 0.8%). See example 1, column 9. The ionic polymer discloses id butyl methacrylate-acrylic copolymer (94.2/5.8) with a TG of 46 degrees Celsius. See examples II. The examiner utilizes this intermediate composition to reject the claims.

It should be noted that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or

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structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

With regard to the functional limitation (e), it is the examiner's position that the prior art discloses the same composition as instantly claimed and thus it will be capable of leaving an water- insoluble film on the nail.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 61-72, 81-84, and 85-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perronin et al (3,991,007) by itself or in view of Strella et al (3,928,656).

Perronin teaches the preparation of pigmentary particles coated with an organic polymer to allow dispersible of the pigment in a medium.. Perronin discusses the importance of pigments in many fields such as textiles, plastics, inks, textiles, and cosmetics. Note column 1, lines 10-12. Perronin teaches examples of monomers which may be used in the process include 1) alkene-

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mono- or di-carboxylic acids, preferably the acids containing up to five carbon atoms, for example acrylic, methacrylic, etc.; 2) esters of these acids, such as methyl, ethyl, butyl, etc. see column 3, lines 40-60.

Example 6 provides a composition with 100 parts a pigment, 350 parts heptane, 90 parts methyl methacrylate, and 10 parts acrylic acid. The pigment composition D is then combined in an amount of 190 parts (50% pigment and 50% 90/10 copolymer of MMA-AA), 50% nitrocellulose resin in butyl acetate in 86 parts, 210 parts ethyl acetate (ester solvent), 22 parts butanol, 155 parts isopropanol, and 28 parts butyl phthalate (plasticizer). Example 13 teaches a copolymer of methyl methacrylate and acrylic acid in the amount of 80-20. Note that nitrocellulose is in the amount of about 6.2% of the total composition; the pigment is in the amount of 13.7%, and the copolymer in the amount of 13.7%.

Although Perronin teaches that the monomers may be selected from several monomer including butyl and methyl esters of methacrylic acid, Perronin does not expressly teaches the instantly claimed butyl methacrylate-acrylic acid copolymer.

Strella discloses a method of developing electrostatic latent images with pressure sensitive toner. Strella teaches preparing a colored toner for forming a uniform dispersion of dye or pigment in a resinous material. The polymers taught include butyl methacrylate-acrylic acid, for providing toner compositions. See column 6, lines 15-30 and examples. The toner comprises 19 parts of an ionic polymer (15.8%), 100 parts of tetrahydrofuran (ether solvent-83.3%), and 1 part Mogul black (pigment- 0.8%). See example 1, column 9. The ionic polymer discloses is butyl methacrylate-acrylic copolymer (94.2/5.8). See examples II. The examiner utilizes this intermediate composition to reject the claims.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to look at the guidance provided by Perronin and utilize either methyl methacrylate or instant butyl methacrylate. One would have been motivated to do so since Perronin teaches several monomers may be copolymerizes such as esters of methacrylic acids including methyl and butyl. Thus a skilled artisan would have been motivated to substitute the exemplified methyl methacrylate with butyl methacrylate, i.e. substitute the exemplified methyl with butyl, since both are analogous compounds, i.e. both are alkyl esters of methacrylic acids. Therefore, absent unexpected results, substituting the prior art's methyl with instant butyl is deemed obvious to a skilled artisan.

Further, Strella demonstrate the prior art wherein it is known to utilize the instant copolymer to coat a pigment for dispersal in a solvent. Therefore, a skilled artisan would have been motivated to look to Strella and utilize the instant copolymer with the expectation of similar results since Strella teaches butyl methacrylate-acrylic acid copolymer as a suitable polymer to coat pigments and Perronin suggests the use of several monomers including esters of methacrylic acids wherein the alkyl may be butyl to coat the pigment.

With regard to the preamble, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

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With regard to the functional limitations, it is the examiner's position that Perronin's composition is capable of leaving a water-insoluble film on the nail since the compositions are substantially similar.

With regard to claim 82, Perronin teaches 6.2% nitrocellulose and not instantly claimed 0.5-5%. However, it would have been obvious to a skilled artisan to manipulate this concentration during routine optimization and experimentation. It should be noted that generally difference in concentrations do not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such as concentration is critical. See *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

With regard to the copolymer molecular weight, the substitution of methyl for butyl will provide a molecular weight of about 68,000. The examiner cites US 5,798,426 as art of interest wherein '426 states that BMA/AA (90/10) has a weight of 69,400, which reads on about 68,000.

Response to Arguments

Applicant argues that the instant claims require dissolving the copolymer in the non-aqueous solvent and Perronin requires the copolymer to be partially soluble. Thus, applicant argues that the concentration of dissolved copolymer could be less than about 5%. Applicant argues that there is not direct teaching of butyl methacrylate and it is only mentioned once in a laundry list.

Applicant's arguments filed 10/12/05 have been fully considered but they are not persuasive. It is noted that the features upon which applicant relies of the copolymer being dissolved in the solvent is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the

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claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims only require the a non-aqueous solvent which Perronin teaches and thus the argument is moot.

With regard to argument the Perronin does not specifically utilize butyl methacrylate, it is the examiner's position that even though it is suggested in a laundry list, the applicant has not provided any unexpected results to overcome the obviousness rejection. Both acrylic acid-methyl methacrylate and acrylic acid-butyl methacrylate are similar compounds wherein one would expect both copolymers to behave similarly if butyl was substituted with the prior art's exemplified methyl. Thus, the claims are rendered obvious.

Claims 73-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perronin et al (3,991,007) optionally in view of Strella et al (3,928,656) in further view Katsen et al (5,746,817).

The teachings of Perronin have been delineated above. In particular Perronin teaches the preparation of pigment particles coated with an organic polymer. Perronin discusses the importance of pigments in many fields such as paints, inks, plastics, and cosmetics. Note column 1, lines 10-12. Perronin teaches the use of dibutyl phthalate in the ink composition.

Perronin does not teach the instant plasticizer.

Katsen teaches an ink composition. Katsen teaches the use of plasticizers such as dibutyl phthalate and dipropylene glycol dibenzoate. See column 5, lines 30-50.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Perronin and Katsen and substitute Perronin's dibutyl phthalate with instantly claimed dipropylene glycol dibenzoate. One would have been motivated to do so since Katsen teaches both dibutyl phthalate and dipropylene glycol dibenzoate function

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as plasticizers. Therefore, a skilled artisan would have expected similar results since the prior art teaches the functional equivalence of Perronin's dibutyl phthalate and instantly claimed dipropylene glycol dibenzoate.

Claims 73-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perronin et al (3,991,007) optionally in view of Strella et al (3,928,656) in view of Hosotte-Filbert et al et al (5,681,877) in further view of Pagano et al (5772988).

Perronin discloses the preparation of pigment particles coated with an organic polymer. Perronin discusses the importance of pigments in many fields such as cosmetics. Note column 1, lines 10-12. Example 6 provides a composition with 100 parts a pigment, 350 parts heptane, 90 parts methyl methacrylate, and 10 parts acrylic acid. The methacrylate-acrylic acid copolymer is 70-30. The pigment composition D is then combined in an amount of 190 parts (50% pigment and 50% instant copolymer) with 86 parts nitrocellulose resin, 210 parts ethyl acetate, 22 parts butanol, 155 parts isopropanol, and 28 parts butyl phthalate (plasticizer). Example 13 teaches a copolymer of methyl methacrylate and acrylic acid in the amount of 80-20. Suitable solvents include ethers and esters. See column 2, lines 60-62.

Perronin does not teach the use of a suspending agent.

Hosotte-Filbert et al teach the use of block polymers (acrylic acid and methyl methacrylate) as dispersing agents of pigments in cosmetics. See abstract. Conventional nail varnish bases utilized contain 10-15% nitrocellulose, 8-12% filler resin, 6-8% plasticizer (dibutyl phthalate), 65-75% solvents (ethyl acetate and butyl acetate), 0.8-1.5% suspending agent (bentone), and the pigment is added depending on the desired color. See example 9.

Hosotte-Filbert does not teach the instant suspending agent.

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Pagano teaches a nail enamel composition containing pigments. Pagano teaches the use of suspension agents such as bentones, stearalkonium bentonite, hectorites, etc. in the amount of 0.1-15% as thickeners. See column 8, lines 1-25. Pagano utilizes plasticizers such as instant dipropylene glycol dibenzoate in the nail enamel.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize conventional additives such as a suspending agents in a conventional varnish base. One would have been motivated to do so since Hosotte-Filbert teaches conventional nail varnish base contains plasticizers, suspending agents, solvents, resins, etc. Therefore, one would have been motivated to look to Hosotte-Filbert if one wanted to utilize Perronin's pigment in a nail composition. Further, one would expect similar results since Perronin teaches the pigmented composition may be used in cosmetics.

Furthermore, one would have been motivated to look to the teachings of Pagano and utilize the instantly claimed suspending agent and plasticizer since Pagano demonstrates the state of the art wherein instantly claimed additives are known in the nail art. A skilled artisan would have been motivated to utilize the instant suspending agent since Pagano teaches that Hosotte-Filbert suspending agent (bentone) and the instant suspending agents are functional equivalents. Therefore, a skilled artisan would have expected similar results the instant suspending agent.

Conclusion

All the claims are rejected at this time.

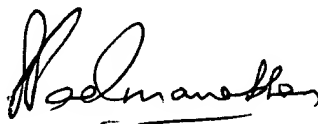
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sharmila S. Gollamudi
Examiner
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SPRENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

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